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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,940	01/10/2001	R. Mark Halligan	77901	8523
24628	7590	10/06/2004		
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			EXAMINER MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,940

Applicant(s)

HALLIGAN ET AL. *ST*

Examiner

Jan Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2001 and 14 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 96-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 96-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on January 10, 2001. Claims 1-95 have been withdrawn by way of a preliminary amendment. Claims 96-118 are currently pending.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on July 30, 2001 is being considered by the examiner.

Specification

3. The abstract of the disclosure is objected to because the abstract is over the 150 word limit. Correction is required. See MPEP § 608.01(b).

Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 96-118 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

What are the values and how are they assigned? How is the one or more metrics generated? What are the logical and mathematical processes used to determine the metrics? What is the predetermined threshold value by which the comparison is made? How is the application fingerprint created?

Furthermore, the applicant's specification does not disclose adequate structure for performing the recited functions. Therefore, the applicant is respectfully requested to specifically point out the means in the claim limitations and the functionality of these means in performing the steps or functions (See MPEP Section 2181).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 96-118 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What are *generally accepted legal criteria*? This is a vague and indefinite phrase.

What does the applicant mean by *creating an application fingerprint from a content of the trade secret*? What is an *application fingerprint* and what is a *content of the trade secret*?

What is a *deterministic one-way algorithm*?

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How is the *certificate fingerprint* created from the application fingerprint?

What are the *sis factors of a trade secret as set forth in Section 757 of the First Restatement of Torts?*

Claim 96 states that it is for a method of protecting a trade secret in the preamble.

However, none of the steps comprise the protecting of a trade secret.

Regarding claims 103 and 112, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 96-104 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to

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pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 96-104 only recite an abstract idea. The recited steps of merely applying a plurality of criteria, assigning a value and generating metrics from the values does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to protect something. There is not technology in the body of the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 96, 102-104, 105, 111-113, 114 and 118 are rejected under 35 U.S.C. 102(e) as being anticipated by Barney et al (US 6,556,992) (hereinafter referred to as Barney).

Barney discloses a method and apparatus comprising the steps of:

a) applying a plurality of generally accepted legal criteria to a content of the trade secret (Barney discloses valuing and rating patents and other intellectual property assets (col. 1, lines 10-15, col. 2, lines 1-4) which would include trade secrets (the valuing requires an understanding of a broad range of legal (which could encompass Section 757 or the First Restatement of Torts),

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technical, and accounting disciplines (col. 2, lines 1-5, col. 5, lines 56-62 – criteria equal breath, defensibility and commercial relevance);

b) assigning a value under each criterion (col. 6, lines 3-9 – statistically based patent rating method and system whereby relative ratings or rankings are generated; and

c) generating one or more metrics from the assigned values through the use of logical and mathematical processes, thereby allowing the comparison of results with predetermined threshold values (col. 6, lines 3-23 – ratings or rankings are generated using a database of patent information by identifying and comparing various characteristics of each patent to a statistically determined distribution (threshold) of the same characteristic).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 97-101 and 106-110 and 115-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barney as applied to claims 96 and 105 above, and further in view of Haber et al (US Patent 5,136,646) (hereinafter referred to as Haber).

Referring to Claims 97, 106 and 115:

Barney disclose a method and system as set forth in claims 96 and 105. Barney does not disclose a method and system of protecting the trade secret further comprising creating an application fingerprint from a content of the trade secret.

However, Haber discloses a method and system of protecting the trade secret further comprising creating an application fingerprint from a content of the trade secret (col. 3, lines 50-62) (Haber discloses the invention as related to intellectual property which would include trade secrets – col. 1, lines 9-12).

It would have been obvious to one of ordinary skill in the art to incorporate into the disclosure of Barney the teachings of Haber since this ensures against interception of confidential document information during transmission to the TSA and prevents the document from being secretly revised.

Referring to Claims 98-101, 107-110, and 116-117):

Haber discloses a method and system of protecting trade secrets (IP encompasses trade secrets, col. 1, lines 9-12) wherein the step of creating the application fingerprint further comprises processing the content of the trade secret using a deterministic one-way algorithm (col. 3, lines 29-49), further comprising transferring the application fingerprint from a creator of the trade secret to a trusted third party col. 2, lines 32-40, col. 3, lines 6-9), creating a certificate fingerprint from the application fingerprint by the trusted third party (col. 4, lines 22-40) and a method and system further comprising transmitting the certificate fingerprint from the trusted third party to the creator of the trade secret as a trade secret certificate (col. 4, lines 22-40).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Parker and Pennington disclose proper protective measures that will enable a company from having confidential information, including trade secrets, misappropriated.

Time Stamp Server discloses a time stamp server system which protects information from being leaked by a third party.

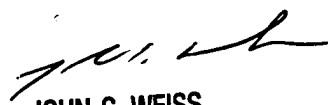
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM


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